

IFW
AF 13625

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Davis et al.

Application No.: 09/502,542

Filed: February 10, 2000

For: METHOD AND SYSTEM FOR
FACILITATING ON-LINE SHOPPING

Examiner: M. Fadok

Date: August 9, 2004

Art Unit 3625

Confirmation No. 5321

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on August 9, 2004 as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF PATENTS, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.

William Y. Conwell
Attorney for Applicant

AMENDMENT ACCOMPANYING APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please amend the subject application as follows:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Davis et al.

Application No.: 09/502,542

Filed: February 10, 2000

For: METHOD AND SYSTEM FOR
FACILITATING ON-LINE SHOPPING

Examiner: M. Fadok

Date: August 9, 2004

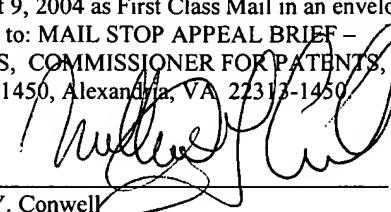


Art Unit 3625

Confirmation No. 5321

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on August 9, 2004 as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF – PATENTS, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450



William Y. Conwell
Attorney for Applicant

TRANSMITTAL LETTER

MAIL STOP APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Enclosed for filing in the above-captioned matter are the following:

- Appeal Brief (in Triplicate) (fee \$330.00)
- Amendment Accompanying Appeal Brief.
- If an extension of time is required, please consider this a petition therefor.
- Please charge \$330.00 (fee for Appeal Brief) and any additional fees which may be required in connection with filing this document and any extension of time fee, or credit any overpayment, to Deposit Account No. 50-1071.

Date: August 9, 2004

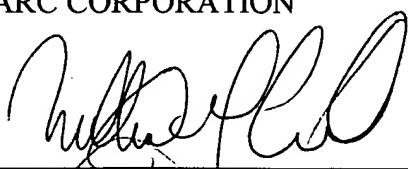
CUSTOMER NUMBER 23735

Phone: 503-885-9699
FAX 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

By _____



William Y. Conwell
Registration No. 31,943



WFC:Imp 60109 8/9/04

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Davis et al.

Application No.: 09/502,542

Filed: February 10, 2000

For: METHOD AND SYSTEM FOR
FACILITATING ON-LINE SHOPPING

Examiner: M. Fadok

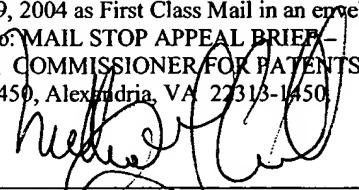
Date: August 9, 2004

Art Unit 3625

Confirmation No. 5321

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on August 9, 2004 as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF – PATENTS, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.


William Y. Conwell
Attorney for Applicant

APPEAL BRIEF

Mail Stop: Appeal Brief – Patents
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed June 7, 2003. Please charge the fee required under 37 CFR 1.17(f) or any deficiency to deposit account 50-1071 (see transmittal letter).

08/11/2004 GWORDDF1 00000036 501071 09502542

01 FC:1402 330.00 DA



I. REAL PARTY IN INTEREST.....	3
II. RELATED APPEALS AND INTERFERENCES.....	3
III. STATUS OF CLAIMS	3
IV. STATUS OF AMENDMENTS.....	3
V. SUMMARY OF THE INVENTION	3
VI. ISSUES	6
VII. GROUPING OF CLAIMS.....	7
VIII. ARGUMENT	7
1. Official Notice	7
2. Claim 1.....	9
3. Claim 7.....	12
4. Claim 3.....	13
5. Claim 4.....	14
6. Claim 5.....	15
7. Claim 6.....	15
8. Claim 7.....	16
9. Claim 8.....	16
10. Claim 9.....	16
11. Claim 12.....	17
12. Claim 13.....	18
13. Claim 14.....	18
14. Claim 10.....	19
15. Claim 11.....	20
16. Claim 9.....	21
17. Claim 15.....	21
18. Claim 16.....	22
19. Claims 17 and 18	22
20. Claim 19.....	23
21. Claim 20.....	24
22. Claim 21.....	25
23. Claim 22.....	25
24. Claim 23.....	25
25. Claim 24.....	26
26. Claim 25.....	26
27. Claim 26.....	27
28. Claim 27.....	28
IX. CONCLUSION.....	28

I. REAL PARTY IN INTEREST

The real party in interest is Digimarc Corporation, by an assignment from the inventors recorded at Reel 10883, Frames 453-455, on May 23, 2000.

II. RELATED APPEALS AND INTERFERENCES

There is no related appeal or interference.

III. STATUS OF CLAIMS

Claims 1, 3-7 and 9-27 stand finally rejected and are appealed. (Claim 2 was canceled during prosecution. Claim 8 is canceled by the accompanying amendment.)

IV. STATUS OF AMENDMENTS

All earlier-filed amendments have been entered.

Submitted with this Appeal Brief is an amendment canceling claim 8, and re-writing claims dependent from claim 8 into independent form.

A clean copy of the claims (assuming entry of the accompanying amendment) is presented in the Appendix.

On reviewing the file, it appears an IDS, submitted by applicants with the original application and identifying a single item of potential art, was returned without the Examiner's initials and without comment as to its consideration. In his Answer, or in a separate paper, the Examiner is requested to address the status of this IDS.

V. SUMMARY OF THE INVENTION

Applicants' invention relates to various improvements that facilitate shopping.

On-line shopping is popular with certain technically adventurous segments of the public, but drawbacks have prevented more widespread adoption.¹

¹ See, e.g., Specification, page 1, lines 8-9.

Consider on-line grocery stores. These virtual storefronts offer an impressive inventory of choices, but have cumbersome user interfaces for product selection.²

Some on-line grocery stores have products arranged by category (e.g., fresh vegetables, canned vegetables, soft drinks, etc.) Each category has further sub-categories. By repeated mouse-clicking through a graphical user interface, the user can hope to drill down through different categories and sub-categories (and sub-sub-categories, etc.) to finally identify a desired product.

An alternative approach is a “Search” option, providing a box into which the shopper can type in the name of a desired product, e.g., *Jif* peanut butter. After entering this data, the user may be presented with a menu of several products that meet the search criteria (e.g., *Jif Chunky*, *Jif Smooth* – each in 4 oz., 8 oz., and 16 oz. sizes).³

These cumbersome selection techniques must be repeated for each desired item.

The net experience is tedious and time consuming; many first-time users give up in despair.⁴

The situation is improved for shoppers who stick with the process and successfully complete one or more on-line orders. Items previously purchased by such users are detailed in a list (a “favorites list”) that is presented when the user next signs-on to the store, and can be re-ordered without the tedious navigation-selection processes just-detailed.⁵

In accordance with one aspect of the present invention, the initial user-interface hurdle to a satisfying shopping experience is overcome by permitting the user to compile a favorites list *through shopping at one or more bricks-and-mortar stores*.⁶

Walking the aisles of such a physical store, the user quickly scans each item that may be of future interest. Each successful “read” of a product indicia (e.g., bar code, RFID) is confirmed with an audio tone or a visible indication. A corresponding product ID (e.g., an SKU, or bar code identifier) is added to a list maintained for that user. After wandering the aisles for ten or 15 minutes, the user has compiled a list of items that can be presented in a virtual on-line

² See, e.g., Specification, page 1, lines 10-11.

³ See, e.g., Specification, page 1, lines 11-16.

⁴ See, e.g., Specification, page 1, lines 18-19.

⁵ See, e.g., Specification, page 1, lines 19-23.

⁶ See, e.g., Specification, page 1, lines 24-26.

store customized for that user.⁷

Rather than scanning items in the aisles, the user may alternatively purchase items at the physical grocery's checkout. Again, the items are scanned, identified, and added to a favorites list associated with that user.⁸

In both cases, when the user later shops on-line, a personalized shopping environment is presented, featuring the items *previously identified* in the bricks and mortar store(s).⁹

More particularly, this aspect of the invention includes the following acts:¹⁰

- presenting a collection of retail items - each having an indicia associated therewith - in a bricks and mortar store offering items for sale;
- sensing the indicia associated with selected ones of said items;
- compiling a list identifying the items whose indicia were sensed;
- storing said list in a data structure associated with a user;
- later recalling said list;
- using said recalled list to present a customized selection of items in an on-line shopping environment; and
- receiving input from a user identifying a subset of items from said customized selection of items.

Optionally, the user can identify desired items in one vendor's bricks and mortar store (e.g., Albertson's), and can later employ the listing thereby compiled in on-line shopping in a different store (e.g., Safeway).¹¹

By the foregoing arrangements, the familiar exercise of visiting a bricks and mortar store is used to facilitate a subsequent on-line shopping experience.

Through use of a list of products associated with a user (e.g., compiled in a physical store – as detailed above, or obtained otherwise), a variety of other enhancements can be made to an on-line shopping experience. For example, if a user enters an on-line order without any dessert or cookie item, a system according to another aspect of the present invention can present a query

⁷ See, e.g., Specification, page 3, lines 11-18.

⁸ See, e.g., Specification, page 1, lines 27-28; page 3, lines 5-10; Fig. 2.

⁹ See, e.g., Specification, page 1, lines 28-30; claim 1.

¹⁰ Claim 1 (as originally filed, and as pending).

listing dessert/cookie items from that user's favorite list - as the order is being finalized - in case the omission was an oversight.¹²

Such suggestion of additional items may be triggered only if the purchase meets one or more criteria. The criteria can include total purchase size (e.g., over \$75), time since last order (e.g., no cookies ordered for 30+ days), etc.¹³

An on-line system can also track the user's purchase habits. If the user customarily orders 3 half gallons of skim milk every week, and a weekly order is entered without such an item, the system can query whether such item should be included before finalizing the order.¹⁴

In accordance with still another aspect of the present invention, an on-line shopping environment is improved by *displaying a virtual shopping aisle*, with *graphical* representations of items for sale - instead of simply textual listings. Thus, a box of Ritz crackers may be represented in a virtual aisle with a depiction of the familiar red box, or by the familiar logo, or both. According to this aspect, items of potential interest to a particular shopper (e.g., items that were identified by reference to that shopper's prior activity in a bricks and mortar store) are presented more prominently in the graphical display (e.g., larger, more brightly, etc.) - facilitating shopping.¹⁵

A variety of other novel arrangements are also presented, as more particularly detailed below.

VI. ISSUE

Did the Office establish *prima facie* obviousness of claims 1, 3-7 and 9-27 over various art and "Official Notice," when (a) the art fails to teach the elements of the claims; (b) certain of the missing elements are dismissed with reference to "Official Notice" - which the Examiner declined to illustrate with a reference when so requested; and (c) the proposed modification and

¹¹ See, e.g., Specification, page 6, lines 8-15.

¹² See, e.g., Specification, page 5, lines 9-13.

¹³ See, e.g., Specification, page 5, lines 14-16.

¹⁴ See, e.g., Specification, page 5, lines 18-20.

¹⁵ See, e.g., page 7, lines 10-16.

combination of the art proceeds in accordance with the Examiner's hindsight and applicants' specification, rather than a suggestion in the art.

VII. GROUPING OF CLAIMS

Claim 4 stands or falls with claim 3.

Each of the other claims is separately patentable, as detailed below.

VIII. ARGUMENT

1. Official Notice

Some of the difficulty in the present application stems from the Examiner's too-heavy reliance on Official Notice, and his mis-understanding of the requirements and procedures governing its use.

A predicate for reliance on Official Notice is that the noticed teaching must be a "fact" outside of the record which is capable of "instant and unquestionable demonstration" (MPEP 2144.03). As detailed below, the Examiner has disregarded this requirement.

Moreover, applicants repeatedly requested substantiation for the "Official Notice" so that these alleged "facts" could be fully addressed during prosecution and appeal.¹⁶ The Examiner repeatedly refused to provide any supporting reference.

¹⁶ The December 19, 2003, *Response*, stated (page 1):

Applicants respectfully traverse the Examiner's reliance on Official Notice for the many teachings not expressed in the art of record.

As such, the Examiner is requested to provide copies of art illustrating the cited teachings, so that Applicants can properly address same in their appeal to the Board. (See MPEP §2144.03, which notes, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.")

(Emphasis added.)

The January 31, 2003, *Response*, similarly stated (page 3):

Again, a predicate for reliance on Official Notice is that the

In the *Response to Arguments* section of his Final Rejection, the Examiner contends he is not required to identify a reference supporting the repeated instances of Official Notice because applicants allegedly did not sufficiently traverse same, citing *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). In particular, the Examiner charged that applicants failed to create a reasonable doubt as to the correctness of the facts as stated by the Examiner.

The Examiner's error is two-fold.

First, the initial burden of establishing obviousness is on the Examiner. A fact imagined by the Examiner – and not supported by written evidence – does not meet this initial burden, when seasonably challenged by applicant. The Examiner's position would place on applicants the untenable requirement of proving a negative – the absence of an alleged fact (and a "fact" that - to date - is manifested only in the Examiner's mind).

Second, the Examiner's reliance on Boon is incorrect.

As noted in the MPEP, *Boon* applies when the *Board of Patent Appeals and Interferences* takes judicial notice of facts not in the record. If the Board took notice of a fact, and the Board's decision were appealed to the Federal Circuit (the CCPA's successor), and applicants failed to create a reasonable doubt as to judicial notice taken by the Board, then *Boon* would apply. In the present case, however, *Boon* does not apply, because the "fact" challenged comes from the Examiner on whom the burden rests, and it is the Examiner that is being challenged on this point.

In the present context, the action required by applicants to compel the Examiner to provide documentary support for alleged Official Notice is set forth in MPEP 2144.03. The MPEP states:

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. A seasonable challenge constitutes a demand for evidence made as soon as practicable

noticed teaching must be a "fact" outside of the record which is capable of "instant and unquestionable demonstration" (MPEP 2144.03). Applicants submit that the feature of claim 3 for which Official Notice is taken is not such a fact. Again, applicants request that the Examiner cite a reference in support of such Official Notice if the rejection is renewed.

(Emphasis added.)

during prosecution.”

Applicants made the requisite “demand for evidence” that constitutes the seasonable challenge.¹⁷ The Examiner has failed to meet his burden by failing to provide the requested evidence.

As noted, a predicate for reliance on Official Notice is that the noticed teaching must be a “fact” outside of the record which is capable of “instant and unquestionable demonstration.” MPEP 2144.03 further explains that the facts of which such Notice may be taken should serve to “fill in the gaps” which might otherwise exist in an evidentiary showing “and should not comprise the principle evidence upon which a rejection is based.” As detailed below, the Examiner has repeatedly relied on Official Notice in a principle role.

For all of these reasons, the Examiner’s rejections premised on Official Notice fail to comply with governing guidelines, and must be reversed for not fulfilling the burden placed on the Office by § 103.

2. Claim 1

Claims 1 and 7 stand rejected as obvious over Scroggie (5,970,469) in view of Official Notice, and further in view of Kenney (6,381,583).

Scroggie is cited for its teachings concerning arrangements by which coupons (“purchase incentives”) are issued to shoppers through their home computers, based on their purchases at a physical store.

More particularly, when physical objects are scanned at a grocery checkout by a scanner in Scroggie’s system, the resulting data is used to provide electronic purchase incentives from the store’s computer to the user’s computer.¹⁸ The user can then employ these purchase incentives in connection with subsequent purchases.¹⁹

In its final rejection of claim 1, the March 3 Action quotes elements from applicants’ claim, and identifies corresponding passages from Scroggie. Applicants agree that certain of the acts recited in claim 1 are present in Scroggie, as alleged by the Examiner.

¹⁷ See footnote 16, above.

¹⁸ Scroggie, U.S. Patent 5,970,469, col. 11, lines 41-47.

When it comes to the penultimate claim limitation, “*using said recalled list* [i.e., a list compiled through sensing retail item indicia in a bricks and mortar store, and stored in a data structure associated with the user] *to present a customized selection of items in an on-line shopping environment,*” the Examiner again alleges this limitation is taught by Scroggie (Final Rejection, page 3, lines 1-2). However, unlike the other claim limitations, the Examiner identifies no corresponding passage from Scroggie evidencing such teaching.

No such teaching of this claim limitation is found in Scroggie.

Applicants noted this shortcoming to the Examiner in their January 31, 2003 Response.²⁰ However, despite applicants’ prompting, the Examiner still has not provided a citation to this alleged teaching.

Because the Examiner relies on Scroggie for a teaching it does not contain, the obviousness rejection fails.

The Final Rejection has a confusing passage following the Examiner’s unsupported citation for the subject claim limitation in Scroggie. However, its relevance is not fully understood. It states:

Scroggie teaches that while on-line, accessing the customers purchasing history, then selecting one or more purchasing incentives based on some aspect of the customer’s prior shopping history (FIG 14, col 12, lines 7-16 and col. 13, lines 1-46), and the emerging technology of online shopping (col. 1, lines 26-35), but does not specifically mention that the scan data is presented to the user in a shopping environment. It is old and well known in the art that profile/preference data stored in databases and available on-line can be readily accessed and used in online shopping environments. It would be obvious to a person of ordinary skill in the art to include in Scroggie presenting scanned data to a shopper in an online shopping environment, because users shopping on-line could also benefit from the targeted incentives and the additional data would increase the effectiveness of the Scroggie.

If the Examiner is here trying to bootstrap from Scroggie the just-discussed penultimate limitation from claim 1, then it fails on a number of points.

First, “presenting scanned data” isn’t the claim limitation at issue.

Second, the teaching of Scroggie referenced here involves the presentation to the consumer of coupons he or she can select from. It does not concern – or contemplate –

¹⁹ Scroggie, U.S. Patent 5,970,469, col. 12, lines 2-6.

applicants' arrangement of using a bricks and mortar store to alleviate navigational difficulties in subsequently finding items in an online store.

Third, the underlined rationale for the proposed extension of Scroggie's teaching relies on "targeted incentives" – a feature not recited in applicants' claim. If this logic leads anywhere, it leads to an arrangement with "targeted incentives" – an arrangement not claimed.

Again, the Examiner has failed to establish a *prima facie* case under § 103.

Still further, the Examiner here relies on Official Notice ("it is old and well known in the art that profile/preference data stored in databases and available on-line can be readily accessed and used in online shopping environments"). As noted, applicants repeatedly asked the Examiner to cite a document showing the noted feature, so that same could be particularly addressed in this appeal.²¹ The Examiner improperly failed to do so,²² and has thus denied applicants an opportunity to fully contest this rejection on appeal.

Moreover, Official Notice here is relied upon in a principle role in the rejection, not simply to "fill the gaps" as counseled by the MPEP.

Again, the Examiner has failed to establish a *prima facie* case under § 103.

The Examiner admits that Scroggie fails to teach the final limitation of claim 1, "*receiving input from a user identifying a subset of items from said customized selection of items*," but cites Kenney for this teaching. Kenney (like the prior art discussed by applicants in their specification) uses a favorites list from which an on-line shopper can make selections. However, the claim requires "identifying a subset of items from said customized selection of items. This "said customized selection" claim language refers back to the manner in which this grouping of items was compiled – namely by reference to activities in a bricks and mortar store. Kenney does not teach this.

For this reason, too, the Examiner has failed to meet his burden of demonstrating obviousness.

For each and all of these reasons, the rejection of claim 1 should be reversed.

²⁰ January 31, 2003, *Response*, page 2, 2d paragraph.

²¹ See footnote 16, above.

²² See discussion above concerning MPEP 2144.03.

3. Claim 7

Claims 7, too, stands rejected as obvious over Scroggie (5,970,469) in view of Official Notice. (Although reference is made in the statement of the rejection to Kenney,²³ no reliance on Kenney is detailed in the Action.)

Claim 7 is somewhat the mirror image of claim 1. *Roughly* speaking, claim 7 involves database-logging of a shopper's habits or preferences in an on-line shopping environment, and using the database information in connection with bricks and mortar shopping by the user.²⁴

Rehashing language from his rejection of claim 1, the Examiner addresses this claim as follows:

Scroggie teaches that while on-line, accessing the customers purchasing history, then selecting one or more purchasing incentives based on some aspect of the customer's prior shopping history (FIG 14, col 12, lines 7-16 and col. 13, lines 1-46), and the emerging technology of online shopping (col. 1, lines 26-35), but does not specifically mention that the information gathered during online shopping is presented to a user in connection with a brick and mortar shopping environment.

(The underlined language seems to be the Examiner's abridgement of claim 7.) The Examiner addresses this admitted shortcoming of the sole reference as follows:

It is old and well known in the art that profile/preference data stored in databases and available on-line can be readily accessed and presented in any number of environments including a brick and mortar shopping environment. It would be obvious to a person of ordinary skill in the art to include in Scroggie the recalling of said logged database records in a brick and mortar store from preference data collected from an online shopping environment, because users shopping in brick and mortar stores could also benefit from the targeted incentives and the addition of this data would increase the effectiveness of the Scroggie. Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include information from an online shopping experience in a preference/profile database then later use it in a brick and mortar shopping environment, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Again, the rejection fails. After admitting the reference does not teach the claimed arrangement, the Examiner proposes that the claimed arrangement is nonetheless obvious

²³ Final Rejection, page 2, 8th and 7th lines from bottom.

²⁴ Specification, page 8, lines 8-13; original claim 7.

“because users shopping in brick and mortar stores could also benefit from the targeted incentives.” Again, however, while “targeted incentives” are a focal point of Scroggie’s disclosure, they are not elements of applicants’ claim. The Examiner’s stated logic leads an artisan to a different combination; not the claimed invention. The rejection thus fails.

Moreover, the rejection proposes that such logged information “can be readily accessed and presented in any number of environments including a brick and mortar shopping environment.” Applicants respectfully submit that the *possibility* of such use of profile data (i.e., “...*can* be readily accessed...”) is not evidence that is *has* been so used in the prior art. The *possibility* envisioned by the Examiner is not prior art.

Still further, the rejection is again premised on Official Notice which the Examiner has declined to substantiate. Here he asserts, “It is old and well known in the art that profile/preference data stored in databases and available on-line can be readily accessed and presented in any number of environments including a brick and mortar shopping environment.” The Examiner’s failure to cite a document showing the claim limitation (which applicants note that the Examiner has not correctly quoted) has left his burden unmet (and has denied applicants the opportunity to more fully address same).

Moreover, in addition to improperly failing to evidence this alleged art by a document, the Examiner has again improperly relied on “Official Notice” for a principle role in the rejection. Again, the MPEP counsels that such Notice should be used only to “fill the gaps.”²⁵

In view of each and all of the foregoing, the Examiner has again failed to establish a *prima facie* case under § 103, and the rejection of claim 7 must accordingly be reversed.

4. Claim 3

Claim 3 (as well as claims 4-9 and 12-14) stand rejected over Kenney (6,381,583) in view of Official Notice.

As noted, Kenney teaches an on-line shopping arrangement.

²⁵ MPEP 2144.03.

Concerning claim 3, applicants agree with the Examiner that Kenney teaches or suggests various of the claim's limitations. The disagreement, however, stems from features that Kenney does not teach.

The Examiner concedes that Kenney does not teach the claim limitation:

...querying the user regarding the possible purchase of an item not selected by the user on said recalled list, before completing the online shopping session.

However, the Examiner seeks to redress this shortcoming of Kenney as follows:

The Examiner notes that comparing lists and deriving a resultant differential is old and well known in the art and could have been used in Kenney if so desired.

(Emphasis added.)

“If so desired” is not an acceptable rationale for an obviousness rejection. It begs – but leaves unanswered - the question of why same would be desired by an artisan at the time the invention was made. Having failed to address this point, the Examiner has failed to establish a *prima facie* case of obviousness.

Moreover, the Examiner is again relying – in a principle role – on Official Notice, disregarding MPEP counsel to the contrary.

And, again, applicants repeatedly asked for the Examiner's assertion of fact to be illustrated by a printed document so that they could more particularly address same during prosecution and in this appeal, but the Examiner again improperly refused.

Again, for each of these reasons the Examiner has failed to meet his burden, and the rejection of claim 3 should be reversed.

5. Claim 4

Claim 4 stands or falls with claim 3, from which it depends.

6. Claim 5

Claim 5 is dependent on claim 3, and the rejection thereof should be reversed for the same reasons.

Moreover, claim 5 is independently patentable. Claim 5 recites:

5. The method of claim 3 which includes selecting said item in accordance with a procedure that depends, in part, on the passage of a predetermined interval of time without the user selecting said item for purchase.

In support of this limitation the Examiner cites Kenney at col. 6, lines 24-37. While this excerpt teaches arguably related subject matter, it does not teach the limitation at issue.

In particular, the cited excerpt of Kenney teaches that, in an on-line shopping environment, a list of items previously bought can be displayed to a user, together with the date of last purchase, and/or the historical frequency of purchase.

Claim 5 is different. It requires that – when the user indicates he is finished identifying products for purchase, he is then queried about possible purchase of an item not originally selected. The particular item proposed is determined, in part, based on passage of a predetermined interval of time without the user selecting that item for purchase.

It will be recognized that this claim arrangement is different from Kenney's presentation of historical shopping data to the user during shopping.

Since the art does not teach the claim limitation for which it is cited, the obviousness rejection of claim 5 fails and must be reversed.

7. Claim 6

Claim 6 is also dependent on claim 3, and the rejection thereof should be reversed for the same reasons.

Again, however, claim 6 is also independently patentable. Claim 6 recites:

6. The method of claim 3 that includes selecting said item only if the total price of items selected by the user meets a pre-determined criterion.

The Examiner is unable to identify this arrangement in Kenney, but alleges it is "inherent."

Again, the Examiner is mistaken.

Claim 6 requires that – when the user indicates he is finished identifying products for purchase, he is then queried about possible purchase of an item not originally selected – but only if the total price of items selected by the user meets a pre-determined criterion.

The Examiner's arguments about inherency notwithstanding, no such arrangement is taught by Kenney.

Since the art does not teach the claim limitation for which it is cited, the obviousness rejection of claim 6 fails and must be reversed.

8. Claim 7

Claim 7 is said in the Final Rejection (bottom of page 4) to be rejected over Kenney in view of Official Notice. However, no further explanation for the rejection is offered. Accordingly, the Examiner has failed to establish a *prima facie* case for rejecting this claim over Kenney in view of Official Notice. (The Examiner separately rejected claim 7 over Scroggie and Official Notice, which rejection was addressed above.)

9. Claim 8

Claim 8 has been canceled by the accompanying amendment, and claims dependent thereon have been rewritten in independent form.

10. Claim 9

Claim 9 is an independent claim, as follows:

9. *In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly*

textual –representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper's prior activity in a bricks and mortar store.

The Final Rejection has a section heading indicating this claim is rejected over Kenney in view of Official Notice.²⁶ However, in the discussion that follows, the claim is not mentioned.²⁷ (The claim was later rejected based on different art, discussed below.)

The rejection of claim 9 over Kenney in view of Official Notice must be reversed.

11. Claim 12

Claim 12 depends from claim 3, and is allowable for the reasons detailed above in connection with claim 3.

Claim 12 is also independently allowable. The claim reads:

12. The method of claim 3 in which the item not selected by the user, but on said recalled list associated with the user, is a dessert or cookie item.

The Examiner tacitly admits that Kenney does not teach this particular arrangement, but argues:

Kenney does not limit the type of product that is presented on its list, therefore, the items that were not selected from a list presented to the user could include any number of products including deserts or cookies.

The Examiner is confusing genus and species. While it is true that a species is sufficient to render obvious (and indeed, anticipates) a genus, it is not true that a genus is sufficient to render obvious a species.

Again, the Examiner has failed to meet the burden imposed on the Office by § 103, and the rejection must again be reversed.

²⁶ March 3, 2004, Final Rejection, page 4, bottom two lines.

²⁷ The March 3, 2004, Final Rejection discusses (on page 6) claim 8, and then claim 12, but does not address claim 9.

12. Claim 13

Claim 13 also depends from claim 3, and is allowable for the reasons detailed above in connection with claim 3.

Claim 13 also is independently allowable. The claim reads:

13. The method of claim 3 in which the item is the subject of said query only if said item has not been purchased by the user for a predetermined period.

The Examiner cites Kenny at col. 9, lines 14-33 for this limitation.

The Examiner is mistaken. Kenney does not teach this limitation. The cited Kenney excerpt reads:

In traveling through the store, the shopper sees the interior of the virtual embodiment of the store as displayed through the respective local computer 20. At the beginning of a travel through the store, the display can show entry through the front door of the store, selection of a shopping cart, and movement to a conventional starting point; however, programming can be used to allow the customer to start at any selected point within the environment of the shopping facility 2. Additionally, programming can allow the shopper to travel down a main aisle and look down each stocked aisle to see images of the products and/or menus of products contained in that aisle. The shopper can then go down each aisle as desired. The beginning of one such stocked aisle is shown in FIG. 4. FIG. 5 shows another type of display of the aisle including an index 26 of the items in the store, a list 28 of items on "special," and a list 30 of items to be ordered based on a predetermined or a calculated frequency. FIG. 6 shows still another type of aisle display, this one including a menu 32 of products available on that aisle.

Again, the Examiner has failed to establish a *prima facie* case under § 103, and the rejection must be reversed.

13. Claim 14

Claim 14 also depends from claim 3, and is allowable for the reasons detailed above in connection with claim 3.

Claim 14 also is independently allowable. The claim reads:

14. The method of claim 3 in which the item is the subject of said query only if the user has demonstrated a prior purchasing habit related to said item, and the omission of said item is not in accordance with said demonstrated habit.

The Examiner cites Kenny at col. 1, lines 25-30 for this limitation.

The Examiner again is mistaken. Kenney does not teach this limitation. The cited Kenney excerpt reads:

Further convenience would be added by creating one or more lists of what the shopper may need to buy based upon historical or predetermined ordering patterns or upon actual selections at the time the shopper is moving through the virtual store shown on the shopper's display.

Again, the Examiner has failed to establish a *prima facie* case under § 103, and the rejection must be reversed.

14. Claim 10

Claim 10 (and also claim 11) stand rejected over Scroggie in view of Jelen (6,129,276).

Claim 10 depends from claim 1, and is allowable for reasons set forth above in connection with claim 1.

Moreover, the rejection of claim 1 relied on Scroggie, Kenney, and Official Notice. By the position taken by the Examiner in connection with claim 1, it is apparent that a rejection of dependent claim 10 cannot stand without reliance also on Kenney (and Official Notice).

Accordingly, the rejection of claim 10 over Scroggie and Jelen is inadequate on its face.

Still further, the Examiner has failed to present a cognizable motivation for the artisan to modify and combine the cited art to yield the claimed combination.

Claim 10 reads:

10. The method of claim 1 in which the sensing comprises sensing said selected items along aisles at which said items are displayed, away from a checkout stand.

Jelen teaches a shopping cart with a tethered barcode reader.

The Examiner's rationale for modifying and combining Scroggie and Jelen is as follows:

It would be obvious to a person of ordinary skill in the art to include in Scroggie the portable barcode scanner and display system that is taught by Jelen, because the incentives that are offered by Scroggie could be provided at an earlier time, when a product is selected and could influence the product selection decision before the items are brought to the counter for check out where it is unlikely that a change in buying behavior would occur.

As before, the Examiner's logic again leads to an arrangement different than that detailed by Applicants' claims. Applicant's invention does not require "incentives" – the focal point of Scroggie's disclosure, and the basis for the Examiner's rationale.

For each of these reasons, the rejection of claim 10 does not meet the statutory burden imposed on the Office by § 103, and must be reversed.

15. Claim 11

Claim 11, like claim 10, stands rejected over Scroggie in view of Jelen (6,129,276).

Like claim 10, claim 11 is dependent on claim 1, and is allowable for the reasons detailed earlier in connection with that claim.

Moreover, like claim 10, the rejection of dependent claim 11 is made on less art that applied against independent claim 1. Again, without incorporating the art cited against claim 1, it is apparent that the rejection of claim 11 is inadequate on its face.

Still further, the Examiner's rationale applied with the rejection of claim 11 is ill-founded.

Claim 11 reads:

11. The method of claim 1 in which the sensing comprises sensing an RFID identifier.

The Examiner cites a passage from Jelen (mis-attributed to Scroggie) in which a “location detection system” can use RFIDs. It will be recognized that the presently claimed arrangement does not concern a location detection system.

Again, the Examiner has failed to carry his burden under § 103.

16. Claim 9

Claim 9 (together with claims 15, 16, 19-21, 23-25, and 27) stand rejected over Kenney in view of Official Notice and Scottyscan (a Businesswire press release).

Claim 9 reads as follows:

9. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual – representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper’s prior activity in a bricks and mortar store.

The Examiner states:

“Kenney teaches identifying items of potential interest by reference to the shopper’s prior activity in a brick and mortar store (FIG 7, Reorder Item).

The Examiner is incorrect; Kenney does not so teach. The cited FIG 7 is a screen shot of an electronic display showing a virtual representation of a grocery aisle.

Again, the Examiner has failed to establish a *prima facie* case, and the rejection must be reversed.

17. Claim 15

Claim 15 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 15 depends from claim 9, and is allowable for reasons given above in connection with that claim. Moreover, claim 15 is independently patentable.

Claim 15 states:

15. The method of claim 9 wherein said activity is activity in a bricks and mortar store associated with the first vendor.

The cited art does not teach this arrangement. Moreover, the Final Action fails to particularly consider the limitation of claim 15.²⁸

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

18. Claim 16

Claim 16 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 16 depends from claim 9, and is allowable for reasons given above in connection with that claim. Moreover, claim 16 is independently patentable.

Claim 16 states:

16. The method of claim 9 wherein said activity is a shopping activity.

Again, the cited art does not teach this arrangement. Moreover, the Final Action fails to particularly consider the limitation of this claim.²⁹

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

19. Claims 17 and 18

There is no statement of rejection in the Final Action for claims 17 and 18. However, in the explanation of rejection on page 8, reference is made to "claims 9, 15-27." Accordingly, it is understood that a rejection of claims 17 and 18 was intended over Kenney in view of Official Notice and Scottyscan.

²⁸ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

²⁹ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

In the single paragraph that purports to detail the rejections of claims 15-27,³⁰ no reference is made to any of the claim limitations of claims 17 or 18.

Accordingly, the Examiner has failed to meet his *prima facie* burden under § 103, and the rejection of these claims must be reversed.

20. Claim 19

Claim 19 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 19 reads:

19. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual – representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest, at least in part, by sensing identification data from products while at the shopper's residence.

Scottyscan teaches a Palm Pilot equipped with a barcode scanner, together with associated software for compiling grocery lists and sending the lists to a grocer for fulfillment.

The Examiner justifies his rejection by stating:

It would be obvious to a person of ordinary skill in the art to include in Scroggie and Kenney the input means as taught by Scottyscan because this method is easier and faster than scrolling through lists of products to select desired items.

(The reference to Scroggie appears to be a typo; it was not mentioned in the statement of rejection.)

The Examiner's logic fails on a number of grounds. For one, he posits Scottyscan as an improvement over "scrolling through lists of products." However, the primary Kenney reference already overcomes that drawback: Kenney provides a graphical representation of a store aisle from which a user selects products. Accordingly, avoiding the need to scroll through a list of products would not lead an artisan to modify Kenney; Kenney already avoids that need.

³⁰ March 3, 2004, Final Rejection, page 8, second-to-last paragraph.

Second, the Examiner has failed to address the claim language. The claim requires display of a virtual shopping aisle with graphical representation of items for sale, where items of potential interest to a shopper are presented more prominently, and those items are identified by actions taken at the shopper's residence. Nothing in the rejection suggests why items displayed in Kenney's virtual aisle would be presented more prominently by reason of actions taken at the shopper's residence. (If, as extrapolated by the Examiner, Scottyscan contemplated scanning items at a shopper's residence, such scanning would only be to add the items to a grocery list, not to change their presentation in a graphical representation of items for sale.)

Again, the Examiner has failed to present a *prima facie* rejection under § 103. Again, the rejection must be reversed.

21. Claim 20

Claim 20 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 20 reads:

*20. A method of facilitating on-line shopping comprising:
collecting data about products of interest during a shopper's visit to a bricks and
mortar store, said data being collected prior to check-out; and
using the data thereby acquired in a later on-line shopping session with said
shopper.*

The Examiner again relies on the screen shot of Kenney's Fig. 7 as teaching something about a shopper's prior activity in a bricks and mortar store. Again, the Examiner is mistaken. Fig. 7 concerns on-line shopping.

Moreover, the Final Rejection fails to address the other limitations of the claim.³¹

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

³¹ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

22. Claim 21

Claim 21 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 21 depends from claim 20, and is allowable for the reasons given above.

Moreover, claim 21 is independently allowable. Claim 21 reads:

21. The method of claim 20 wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store.

The Examiner failed to address this claim limitation in his rejection.³²

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

23. Claim 22

There is no statement of rejection in the Final Action for claim 22. However, in the explanation of rejection on page 8, reference is made to "claims 9, 15-27." Accordingly, it is understood that a rejection of claim 22 was intended over Kenney in view of Official Notice and Scottyscan.

Claim 22 depends from claim 20, and is allowable for the reasons given above.

Moreover, claim 22 is independently allowable. Claim 22 reads:

22. The method of claim 20 wherein the data collection includes shopper activation of a shelf-based sensor associated with a product of interest.

Again, the Examiner failed to address this claim limitation in his rejection.³³

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

24. Claim 23

Claim 23 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 23 also depends from claim 20, and is allowable for the reasons given above.

³² March 3, 2004, Final Rejection page 8, second-to-last paragraph.

Moreover, claim 23 is independently allowable. Claim 23 reads:

23. The method of claim 20 wherein the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest.

Again, the Examiner failed to address this claim limitation in his rejection.³⁴

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

25. Claim 24

Claim 24 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 24 depends from claim 1, and is allowable for the reasons given above.

Moreover, like claims 10 and 11, the rejection of dependent claim 24 is made on less art that applied against independent claim 1. Again, without incorporating the art cited against claim 1, it is apparent that the rejection of claim 24 is inadequate on its face.

Still further, claim 24 is independently allowable. Claim 24 reads:

24. The method of claim 1 wherein at least one of said items is sensed while located in an aisle of the store, rather than at checkout.

Again, the Examiner failed to address this claim limitation in his rejection.³⁵

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

26. Claim 25

Claim 25 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 25 depends from claim 1, and is allowable for the reasons given above.

³³ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

³⁴ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

³⁵ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

Moreover, like claims 10, 11 and 24, the rejection of dependent claim 25 is made on less art that applied against independent claim 1. Again, without incorporating the art cited against claim 1, it is apparent that the rejection of claim 25 is inadequate on its face.

Still further, claim 25 is independently allowable. Claim 25 reads:

25. The method of claim 1 wherein the sensing of at least one item occurs without an associated purchase transaction.

Again, the Examiner failed to address this claim limitation in his rejection.³⁶

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

27. Claim 26

There is no statement of rejection in the Final Action for claim 26. However, in the explanation of rejection on page 8, reference is made to "claims 9, 15-27." Accordingly, it is understood that a rejection of claim 26 was intended over Kenney in view of Official Notice and Scottyscan.

Claim 26 depends from claim 1, and is allowable for the reasons given above.

Moreover, like claims 10, 11, 24 and 25, the rejection of dependent claim 26 is made on less art that applied against independent claim 1. Again, without incorporating the art cited against claim 1, it is apparent that the rejection of claim 26 is inadequate on its face.

Still further, claim 26 is independently allowable. Claim 26 reads:

26. The method of claim 1 in which the bricks and mortar store is associated with a first vendor, and the recalled list is used by a second vendor distinct from the first, to present a customized selection of items in an on-line shopping environment.

Again, the Examiner failed to address this claim limitation in his rejection.³⁷

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

³⁶ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

³⁷ March 3, 2004, Final Rejection page 8, second-to-last paragraph.

28. Claim 27

Claim 27 also stands rejected over Kenney in view of Official Notice and Scottyscan.

Claim 27 depends from claim 3, and is allowable for the reasons given above.

Moreover, claim 27 is independently allowable. Claim 27 reads:

27. The method of claim 3 in which the on-line shopping session is with a first vendor, yet products included on the recalled list include products that the user has not purchased from the first vendor.

Again, the Examiner failed to address this claim limitation in his rejection.³⁸

Again, the Examiner has failed to meet his burden, and the rejection must be reversed.

IX. CONCLUSION

The Examiner established a *prima facie* case for none of the claims. The rejections should be reversed, and the case passed to issuance.

Date: August 9, 2004

CUSTOMER NUMBER 23735

Phone: 503-885-9699

FAX 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

By _____

William Y. Conwell

Registration No. 31,943

³⁸

March 3, 2004, Final Rejection page 8, second-to-last paragraph.

APPENDIX A
PENDING CLAIMS

1. A method comprising:

presenting a collection of retail items, each having an indicia associated therewith, in a bricks and mortar store offering items for sale;
sensing the indicia associated with selected ones of said items;
compiling a list identifying the items whose indicia were sensed;
storing said list in a data structure associated with a user; and
later recalling said list;
using said recalled list to present a customized selection of items in an on-line shopping environment; and
receiving input from a user identifying a subset of items from said customized selection of items.

2. (Canceled)

3. A method of conducting an online shopping session comprising:

identifying a user by reference to a login identifier;
recalling a list of products associated with the user;
presenting products from said list to the user for selection;
receiving user selections of products to be purchased;
receiving an indication that the user is finished selecting products; and
thereafter querying the user regarding possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session.

4. A computer storage medium having instructions thereon causing a computer to perform the process of claim 3.

5. The method of claim 3 which includes selecting said item in accordance with a procedure that depends, in part, on the passage of a predetermined interval of time without the user selecting said item for purchase.

6. The method of claim 3 that includes selecting said item only if the total price of items selected by the user meets a pre-determined criterion.

7. A method comprising:

logging a shopper's habits or preferences exhibited in an on-line shopping environment in one or more database records associated with that shopper; and

recalling said logged database record in a bricks and mortar store and using the logged information in connection with bricks and mortar shopping by said user.

8. (Cancelled)

9. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual – representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper's prior activity in a bricks and mortar store.

10. The method of claim 1 in which the sensing comprises sensing said selected items along aisles at which said items are displayed, away from a checkout stand.

11. The method of claim 1 in which the sensing comprises sensing an RFID identifier.

12. The method of claim 3 in which the item not selected by the user, but on said recalled list associated with the user, is a dessert or cookie item.

13. The method of claim 3 in which the item is the subject of said query only if said item has not been purchased by the user for a predetermined period.

14. The method of claim 3 in which the item is the subject of said query only if the user has demonstrated a prior purchasing habit related to said item, and the omission of said item is not in accordance with said demonstrated habit.

15. The method of claim 9 wherein said activity is activity in a bricks and mortar store associated with the first vendor.

16. The method of claim 9 wherein said activity is a shopping activity.

17. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual –representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper's prior activity in the a bricks and mortar store, wherein said items of potential interest include at least one item that the shopper has not previously purchased from said first vendor.

18. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual –representations of items for sale, wherein items of potential interest to a shopper are presented more prominently than other items, and that includes identifying items of potential interest by reference to the shopper's prior shopping history, where said history includes transactions with vendors other than said first vendor

19. In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical – rather than strictly textual –representations of items for sale, wherein items of potential interest to a shopper are presented more prominently

than other items, and that includes identifying items of potential interest, at least in part, by sensing identification data from products while at the shopper's residence.

20. A method of facilitating on-line shopping comprising:
collecting data about products of interest during a shopper's visit to a bricks and mortar store, said data being collected prior to check-out; and

using the data thereby acquired in a later on-line shopping session with said shopper.

21. The method of claim 20 wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store.

22. The method of claim 20 wherein the data collection includes shopper activation of a shelf-based sensor associated with a product of interest.

23. The method of claim 20 wherein the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest.

24. The method of claim 1 wherein at least one of said items is sensed while located in an aisle of the store, rather than at checkout.

25. The method of claim 1 wherein the sensing of at least one item occurs without an associated purchase transaction.

26. The method of claim 1 in which the bricks and mortar store is associated with a first vendor, and the recalled list is used by a second vendor distinct from the first, to present a customized selection of items in an on-line shopping environment.

27. The method of claim 3 in which the on-line shopping session is with a first vendor, yet products included on the recalled list include products that the user has not purchased from the first vendor.